

### **REMARKS**

The specification has been amended. Claims 1-27 are present in the application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

#### **Transfer of Responsibility**

When this application was filed, the Applicants were represented by the law firm of Duane Morris LLP. Later, responsibility for the application was transferred from Duane Morris LLP to the law firm of Kirkpatrick & Lockhart Preston gates Ellis LLP. Applicants now wish to advise the Examiner that, after issuance of the present Office Action on November 15, 2006, responsibility was transferred again, from the Kirkland firm to the law firm of Haynes and Boone L.L.P. A revocation of the existing power of attorney and a new power of attorney will be submitted in due course. In the meantime, the undersigned is acting under the provisions of 37 C.F.R. §1.34.

#### **Claims Not Subject To Rejection**

Noted with appreciation is the fact that Claims 16, 18-19, 24 and 26-27 are not subject to any ground of rejection or objection. Accordingly, these claims should all be allowable, and notice to that effect is respectfully requested.

#### **Drawing Objection**

The Office Action objected to Figure 2, indicating that paragraph [0009] of the specification referred to reference numeral 202 in Figure 2, but reference numeral 202 did not actually appear in Figure 2. The foregoing amendments to paragraph [0009] change each occurrence of reference numeral "202" to "106", because "106" is the reference numeral actually used in Figure 2 to identify the structure in question. This amendment to paragraph [0009] does not introduce any new matter into the disclosure of the invention, but merely conforms the

specification to a drawing, as permitted by MPEP §2163.06. It is respectfully submitted that this amendment eliminates the inconsistency between Figure 2 and paragraph [0009], and thus obviates the drawing objection set forth in the Office Action. Notice to that effect is respectfully requested.

Compliance With 35 U.S.C. §112, Second Paragraph

The Office Action rejects Claims 1-8 under the second paragraph of 35 U.S.C. §112 as indefinite. In particular, with reference to MPEP §2172.01, the Office Action asserts that independent Claim 1 omits an essential step, which is a cleaning step. This rejection is respectfully traversed, for the following reasons. First, the rejection is not consistent with the provisions of MPEP §2172.01. In particular, §2172.01 specifies that if a claim omits essential matter, then the claim may be rejected under the first paragraph of 35 U.S.C. §112 as non-enabling. In addition, §2172.01 specifies that if a claim recites essential elements but fails to interrelate them, then the claim may be rejected under the second paragraph of §112 as indefinite. However, the present rejection is not consistent with either of these potential grounds of rejection.

Further, Claim 1 is an originally-filed claim, and the originally-filed claims are by definition a part of the specification. (See MPEP §608.01(a), and the second paragraph of 35 U.S.C. §112). Consequently, it cannot be said that Claim 1 omits a step that the specification teaches is essential, because Claim 1 is a portion of the specification, and makes it clear there is at least one form of the invention in which a separate cleaning step is not essential. Moreover, other portions of the present specification clearly teach that the recited surfactant can have a beneficial cleaning effect even during a light-exposing operation. For example, see paragraph [0013].

For the foregoing reasons, it is respectfully submitted that the §112 rejection is inherently defective, and that in any event Claim 1 is not missing an essential step. Claims 1-8 are believed to be in compliance with §112, and notice to that effect is respectfully requested.

### Double Patenting Rejections

The Office Action rejects many of the claims for obviousness-type double-patenting, based on other co-pending applications. These grounds of rejection are each respectfully traversed, because they have several fundamental defects that are discussed separately below.

A first defect relates to the fact that the present application was filed before each of the co-pending applications that are relied on in the double patenting rejections. Consequently, as specified in MPEP §804, the Examiner needs to establish "two-way" obviousness in order to make a double patenting rejection, rather than just "one-way" obviousness (unless the Examiner can establish that an exception applies). In other words, the Examiner must establish (1) that specified claims of the present application would be obvious in view of specified claims of the co-pending application, and (2) that those same claims of the co-pending application would be obvious in view of the specified claims in the present application. The Office Action fails to even attempt to establish two-way obviousness, and offers no explanation as to why the Examiner has not carried the burden of establishing two-way obviousness. In the absence of the required showing of two-way obviousness, it is respectfully submitted that the entire double patenting rejection is incomplete and fundamentally defective, and must be withdrawn.

A second defect is that each double patenting rejection basically makes a relatively vague assertion that a group of claims in the present application recite effectively the same invention as a group of claims in a co-pending application. But in order to be proper, the double patenting rejection must set forth a one-to-one correspondence between each pending claim of the present application and a respective one of the claims of the co-pending application. For example, the rejection would need to specify that Claim A of the present application is obvious from Claim X of the co-pending application, Claim B of the application is obvious from Claim Y of the co-pending application, Claim C of the application is obvious from Claim Z, and so forth. In addition, as to each such one-to-one pairing, the Office Action would need to indicate how the claim from the present application differs from the associated claim in the co-pending

application, and then explain why it would be obvious to modify the subject matter of the claim from the co-pending application in order to obtain the subject matter recited in the claim of the present application. The Office Action fails to do so. Moreover, with reference to the discussion of "two-way" obviousness in the preceding paragraph, the Office Action would then need to take these same one-to-one pairings of claims, and perform the reverse obviousness analysis. In particular, the rejection would need to specify that Claim X of the co-pending application is obvious from Claim A of the present application, Claim Y of the co-pending application is obvious from Claim B of the present application, Claim Z of the co-pending application is obvious from Claim C, and so forth. Further, as to each such one-to-one pairing, the Office Action would need to indicate how the claim from the co-pending application differs from the associated claim in the present application, and then explain why it would be obvious to modify the subject matter of the claim in the present application in order to obtain the subject matter recited in the claim of the co-pending application. The Office Action fails to do any of this. The double patenting rejection is thus very incomplete, and it is respectfully submitted that it must be withdrawn.

A third defect relates to the fact that the Office Action admits Applicants' claims are not identical to the claims in the co-pending applications, and then essentially asserts that the subject matter in Applicants' claims involves an obvious modification to subject matter claimed in the co-pending applications. However, as an integral part of this obviousness determination, the Office Action must establish that the prior art would motivate a person of ordinary skill to make each such proposed modification. Here, the Office Action completely ignores motivation.

Still another consideration is that each of the double-patenting rejections is indicated to be a provisional double-patenting rejection, due to the fact that none of the co-pending applications has actually issued as a patent. MPEP §804(I)(B) specifies that, where a provisional double patenting rejection is the only remaining rejection in an application, the Examiner should withdraw the provisional rejection, permit a patent to issue from that application, and then apply a regular (non-provisional) double patenting rejection in the other pending application. For

reasons discussed in these remarks, it is believed that all grounds of rejection in the present Office Action have no merit. Thus, to the extent that the double patenting rejection might remain as the only ground of rejection, it would be improper to issue a further Office Action containing only a provisional double patenting rejection. Instead, according to the MPEP, the Examiner should issue a notice of allowance.

In view of the various different reasons discussed above, it is respectfully submitted that the double patenting rejections are each incomplete in several different aspects, and thus defective. It is therefore respectfully submitted that the double patenting rejections must all be withdrawn.

#### Claim 1-3 Are Distinct From The Smith Publication

Claims 1-3 stand rejected under 35 U.S.C. §103 as obvious in view of Smith U.S. Patent Application Publication No. 2005/0270505. This ground of rejection is respectfully traversed. The PTO specifies in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In regard to establishing a *prima facie* case of obviousness, the provisions of MPEP §2142 specify with respect to §103 that:

To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

In the present situation, independent Claim 1 recites a "fluid containing a surfactant". The §103 rejection is based solely on Smith, and page 5 of the Office Action admits that Smith "does not teach the fluid containing a surfactant". Smith thus does not disclose all of the limitations in Claim 1, and Smith therefore clearly fails to meet one of the minimum requirements set forth in MPEP §2142 for making a prima facie showing of obviousness under §103.

In regard to establishing a prima facie case of obviousness, the provisions of MPEP §2142 also state that:

To establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, and not based on applicant's disclosure.

In the present Office Action, the Examiner asserts that it would be obvious to modify Smith's fluid by adding a surfactant, because Smith discloses that his water can include an additive. However, what Smith actually teaches is that the water can include an additive intended specifically to give the water a desired index of refraction. There is nothing in Smith that would even remotely motivate a person of ordinary skill to use an additive for some purpose other than obtaining a particular index of refraction.

Therefore, where did the Examiner come up with the idea of modifying Smith so as to add a surfactant to the fluid? Since this idea is clearly not present in the Smith reference, the Examiner necessarily came up with this idea based on hindsight of Applicants' disclosure. In particular, using Applicants' disclosure as a blueprint, the Examiner selectively extracted Applicants' idea of using a surfactant, and then incorporated this idea into Smith with a 20/20

view of the desired result. The courts permit the use of some types of hindsight, but prohibit the use of other types of hindsight. In particular, and as emphasized in the above quote from MPEP §2142, the courts prohibit the use of hindsight of Applicants' disclosure. Stated differently, the courts prohibit use of the particular type of hindsight that the Examiner necessarily used here.

For each of the various different reasons discussed above, it is respectfully submitted that Claim 1 is not rendered obvious under §103 by Smith. Claim 1 is therefore believed to be allowable, and notice to that effect is respectfully requested. Claims 2-3 depend from Claim 1, and are also believed to be distinct from the art of record, for example for the same reasons as Claim 1.

#### Conclusion

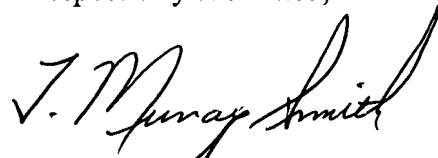
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way

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by a telephone conference, the Examiner is invited to telephone the undersigned attorney at  
972-739-8647.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. Murray Smith", written in a cursive style.

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